

REMARKS

Claim 1–3, 5–9, and 11–14 remain in the application. Independent claims 1 and 7 have been amended by this amendment.

In the Office Action mailed June 16, 2005, Claim 1 was rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,787,089 to Nguyen, claims 1–3 and 6 were rejected under 35 U.S.C. §103(a) as being unpatentable over Japanese Patent Publication No. 11-308163 to Atsushi in view of U.S. Patent No. 5,950,139 to Korycan, claim 5 was rejected under 35 U.S.C. §103(a) as being unpatentable over the publication to Atsushi in view of the patent to Korycan and further in view of U.S. Patent No. 6,262,686 to Delaminat et al. and U.S. Patent No. 6,167,288 to Ishihara, claims 7–9 and 12 were rejected under 35 U.S.C. §103(a) as being unpatentable over the publication to Atsushi in view of the patent to Korycan and further in view of U.S. Patent No. 6,625,478 to Nonogaki, claim 11 was rejected under 35 U.S.C. §103(a) as being unpatentable over the publication to Atsushi in view of the patent to Korycan and further in view of the patents to Nonogaki, Delarminat et al., and Ishihara, claim 13 was rejected under 35 U.S.C. §103(a) as being unpatentable over the publication to Atsushi in view of the patents to Korycan and Delaminat et al., and claim 14 was rejected under 35 U.S.C. §103(a) as being unpatentable over the publication to Atsushi in view of the patents to Korycan, Nonogaki and Delaminat et al. The rejections were responded to in the Remarks of the Request for Reconsideration filed under 37 C.F.R. §1.116 filed on August 8, 2005, which are incorporated herein by reference.

It was pointed out to the Examiner in the prior Remarks that the purpose of the functioning mode-indicator is to indicate whether the portable telephone is in either communicative or noncommunicative mode. As described in the specification, the lighting of the lamp only signifies that the portable telephone is active but cannot communicate with other PDAs or telephones through a telephone network (i.e., the noncommunicative mode). The limitation pointed to in claims 1 and 7 which was relied on to patentably define over the references was as follows: “wherein said functioning mode-indicator is situated at a position

which is easily seen by persons other than said user.”

In his response to the Request for Reconsideration in the Advisory Action mailed September 7, 2005, the Examiner stated that the foregoing limitation was “indefinite since the phrase ‘easily seen’ is not well defined, i.e. is it easily seen from three-feet away with light-on? is it easily seen from 50-feet out with light - off? or is it easily seen all the time from anywhere no matter how the portable device (phone) is situated and whether the portable device is in operation (communication-mode or non-communication-mode) or not (dvice [sic] power-off).” The Examiner indicated that he would give no patentable weight to the limitation because of the indefiniteness he preceived. The position taken by the Examiner in the Advisory Action that the subject claim limitation is indefinite was newly raised in the Advisory Action, the Examiner having made no rejection of the claims under 35 U.S.C. §112, second paragraph, in the Office Action mailed June 16, 2005.

This amendment is made for the purpose of responding to the Examiner’s assertion of indefiniteness of the claims. Specifically, claim 1, as amended, now recites “wherein said functioning mode-indicator is situated close by an antenna or on a top of a cabinet of the portable telephone to indicate to persons other than said user whether the portable telephone is in either a communicative or a noncommunitative mode.” Thus, as amended, the question as to what is “easily seen” is not something that needs further definition. A similar amendment has been made to claim 7.

It is respectfully submitted that, as amended, claims 1 and 7, and hence the claims dependent thereon, not only are definite within the meaning of the Patent Statute, they also clearly and patentably define over the prior art of record.

In view of the foregoing, it is respectfully requested that the application be reconsidered, that claims 1-3, 5-9, and 11-14 be allowed, and that the application be passed to issue.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "C. Lamont Whitham", written in a cursive style.

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